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09/621,857	07/24/2000	Steven D. Clark	4547-8	5123

7590

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EXAMINER

REDDICK, MARIE L

ART UNIT

PAPER NUMBER

1713

DATE MAILED: 08/13/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/621,857

Applicant(s)

CLARK ET AL.

Examiner

Judy M. Reddick

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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**DETAILED ACTION**

**Response to Amendment**

1. The amendment to the claims filed on 11/06/02 has been entered and carefully considered. A new search, based on the amended claims, broader in meaning, has been implemented and as a result, newly discovered prior art has come to the Examiner's attention and a rejection based on such is deemed proper and is as set forth infra. The indication of allowability of claims 1-10 in the previous Office Action (paper no. 7, 05/06/02) is herein, regrettably, rescinded.

**Claim Rejections - 35 USC § 112**

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

*The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.*

3. Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for certain (poly)urethane-based thickeners as housed in Table 1, does not reasonably provide enablement for compounds falling within the broad scope of the claimed "associative thickener". The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

**Claim Rejections - 35 USC § 112**

4. Claims 4, 14 and 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. As far as the Examiner can tell and without any guidelines from applicants as to where support might be found, no support can be found for the newly recited limitation "compounded with a sulfonate which sulfonate may be either alkaline" and this, as such, engenders a New Matter situation.

**Claim Rejections - 35 USC § 102**

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5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

*A person shall be entitled to a patent unless –*

*(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.*

7. Claims 2, 7-10, 12 and 17-20 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over *Guhde et al* (U.S. 5,868,819).

*Guhde et al* disclose and exemplify water-reducible, chromium-free coating compositions for providing corrosion protection to a substrate, such as a metal substrate wherein, said coating compositions are defined basically as containing (A) water to provide an aqueous medium, from about 30 to 60 wt.%, based on total composition wt. ;(B) high-boiling organic liquid;(C) particulate metal;(D) thickener, in an amount of between 0.05 and about 2.0 wt.% and inclusive of, e.g., cellulosic thickeners with the understanding that some to all of the thickener may be replaced by other thickener such as urethane associative thickeners;(E) water-reducible, epoxy functional silane binding agent contributing from about 3 to about 20 weight percent of the total composition weight and other conventional adjuncts which include 0.1 to about 3 wt.% of a nonionic surfactant which may be added with the antecedently recited "thickener", from about 0.1 to about 2.0 weight percent of a corrosion-inhibitor, basis total composition weight, wherein said corrosion-inhibitor is selected from the group consisting of calcium nitrate, dibasic ammonium phosphate, calcium sulfonate, lithium carbonate, and their mixtures. *Guhde et al* @ col. 4, lines 44 teach that when thickener is used, it is usually the last ingredient added to the formulation. See, e.g., the Abstract, cols. 2-8, the Runs

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and the claims of Guhde et al. More specifically, Guhde et al teach, by way of examples, processes for producing the water-reducible coating compositions which basically involve forming a precursor mixture containing a non-ionic surfactant and water, adding thereto a silane and water and agitating so as to form a bath and adding to the bath, with agitation, a lithium carbonate corrosion inhibitor and blending therewith a cellulose thickener. In particular, Guhde et al, by way of example, illustrate the following process: A precursor mixture, as described in Run 1, was blended with a gamma-glycidioxypropyltrimethoxysilane in the manner of Run 1 to provide a mixture of 58.4 weight parts precursor and 5.9 weight parts silane. To this there was added 35.1 weight parts of deionized water, with mixing until uniform. To 850 weight parts of this bath there was then added, with moderate agitation, 1.2 percent by weight of orthoboric acid and 0.28 percent by weight of lithium carbonate(corrosion inhibitor). There was then blended with the resulting bath 0.2 percent by weight of hydroxypropylmethyl cellulose thickener to prepare the coating composition. See Run 2/1, Run 4/1 and Run 6/1. Guhde et al therefore anticipate the instantly claimed invention with the understanding that one of ordinary skill in the art, based on their equivalent teaching, would have readily envisaged the use of calcium sulfonate in lieu of the lithium carbonate + an associative thickener, viz., a urethane associative thickener, in lieu of the cellulosic thickener per run 2 and with the understanding that the manner in which the amine-free emulsion of an alkaline earth metal sulfonate compound, as claimed, is formed is immaterial as provided for under the auspices of *In re Thorpe*, 227 USPQ 964.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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10. *This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).*

11. *Claims 1, 3-6, 11 and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guhde et al (U.S. 5,868,819).*

*The disclosure of Guhde et al for what it teaches and as applied to claims 2, 7-10, 12 and 17-20 as stated in the prior art rejection supra per paragraph #7. Further, the disclosure of Guhde et al differs basically from the claimed invention as per the order in which the mixing of the ingredients is performed per Guhde et al is slightly different from the ingredient admixing steps per the claimed invention. However, the selection of any order of performing process steps would have been prima facie obvious to the skilled artisan, in the absence of new or unexpected results, and with a reasonable expectation of success. Reference In re Burhans, 154 F.2d 690, 69 USPQ, 330 (CCPA 1946).*

*As to the dependent claims, the limitations are either suggested by Guhde et al or would have been obvious to the skilled artisan and with a reasonable expectation of success.*

#### **Response to Arguments**

12. *Applicant's arguments filed 11/06/02 have been fully considered but they are not persuasive.*

*While Counsel, in a good faith effort, attempted to remedy the 112 issues raised in the previous Office action, the 112, first paragraph issue remains as per reasons set forth supra. Applicants' invention, as described in the specification, is drawn to a method of producing amine-free emulsions, which provide, inter alia, improved pigment wetting and dispersion in water borne resin systems. Because it is believed that the nature of the ingredients used in making the "amine-free emulsions" would affect such, it is doubted that all would be operable or that given the present specification, one could determine, without undue experimentation, which are or are not operable falling within the broad scope of the claims.*

#### **Conclusion**

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13. *The prior art to Magyar(U.S. 5,851,961) made of record and not relied upon is cited as of interest in teaching an oil-in-water dispersion composition comprising a mixture of water, an over based colloidal disperse system, a water-soluble associative thickener and at least one dispersant. A rejection in the future, based on this prior art, may be made. The remaining prior art listed on the attached FORM PTOL 892 is cited as of being illustrative of the general state of the art.*

14. *Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).*

*A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.*

*Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..*

*If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)892-9311 for After Final communications.*

*Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.*

*Judy M. Reddick*  
Judy M. Reddick  
Primary Examiner  
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JMR *JMR*  
August 5, 2003